

## **REMARKS**

### **Amendments to the Specification**

The examiner objected to an informality of the specification relating to the claim of priority. Office Action at 2. Paragraph [0001] on page 1 of the specification has been amended as specified by the examiner properly to claim priority. Reconsideration of the examiner's objection respectfully is requested.

### **Amendments to the Claims**

The claims have been amended to address the rejections of the examiner. Claim 4 has been cancelled. Claims 7-9 are new claims. No new matter has been added. All amendments and new claims are fully supported by the specification of the present application.

### **Rejection Under 35 U.S.C. § 102(e)**

The examiner rejected claims 1-3 under 35 U.S.C. § 102(e) as anticipated by Kaplan (U.S. Pat. No. 6,514,193). Applicant respectfully disagrees because Kaplan does not teach or disclose each element of independent claim 1, from which both claims 2 and 3 depend. Specifically, Kaplan does not teach or disclose a method for threading together with a material a plurality of tubular treatment seeds with a bore through each said seed. Claim 1 as amended teaches, in relevant part, "creating a treatment strand by threading a material through a bore through the treatment seeds . . .". The amendment finds support in the specification, which discloses:

The tubular shaped radioactive seed 21 . . . has ends 22, and the hollow bore 23 through the center of the seed 21 communicates with the ends 22 of the seed 23. Also shown [in Fig. 1] is the material 24 that passes through the bore 23 of the seed 21 and makes the assembly axially rigid and radially or laterally flexible.

Application ¶ [0063].

In contrast, Kaplan does not teach threading a polymer through each seed, or even that each seed has a bore therethrough for receiving said polymeric strand. Rather, Kaplan teaches that it is “generally preferred that spacer 52 be *attached to the ends of the seeds* 10 that the ends would be adjacent to one another when the chain 50 is inserted into the barrel of a brachytherapy implantation needle.” Kaplan Col. 15, ll. 6-9 (emphasis supplied).

Further, the present application teaches that, “[t]he material may be inserted into the bore 23 of the seed 21 as a suture and then heated, causing the suture to expand and fix the seeds 21 in position.” Kaplan fails to teach this element, found in new claims 7 and 9.

For at least the foregoing reasons, independent claim 1 and dependent claims 2 and 3, which depend from claim 1, of the present invention are not anticipated by Kaplan. Accordingly, Applicant respectfully requests reconsideration of the rejection based on section 102(e) and a notice of allowance.

#### **Rejection Under Section 35 U.S.C. § 103(a)**

In the alternative to the above rejection over Kaplan pursuant to 35 U.S.C. § 102(e), the examiner rejected claims 1-3 of the present application as obvious over Kaplan in view of Mentor Corporation. To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the reference(s) must teach or suggest all the claim limitations. MPEP § 706.02(j).

As discussed above in the context of addressing the examiner's rejection under section 102(e), Kaplan fails to teach or suggest every limitation of the claimed invention. The Mentor Corporation cited art further fails to teach or suggest the method of threading tubular treatment seeds on suture material, with or without crimping of the material between adjacent seeds, with heating of the material to fix the seeds. As such, a *prima facie* case of obviousness has not been made and the present invention is allowable over the cited art. Applicant therefore respectfully requests reconsideration of the rejection under section 103(a) based on Kaplan and Mentor Corporation.

The examiner rejected claim 4 of the present invention pursuant to section 103(a) based on Kaplan as applied to claim 1, in view of Rapach et al. (U.S. Pat. Pub. No. 2004/0015037 A1) ("Rapach"). Claim 4 has been cancelled, and the rejection therefore is moot.

The examiner also rejected claim 5 as being unpatentable over Kaplan in view of Rapach as applied to claims 1 and 4, and further in view of Reit et al., "Ultrasonically guided transperineal seed implantation of the prostate: modification of the technique and qualitative assessment of implants," *Int'l J. Radiation Oncology Biol. Phys.*, Vol. 24, pp. 555-558 (1992) ("Reit"). Claim 5 depends from claim 1. For at least the reasons set forth above, claim 1 is neither anticipated by Kaplan, nor obvious over Kaplan in view of Mentor Corporation. Reit adds nothing to the cited references that would render obvious claim 1 as amended. That is, Reit does not teach or disclose a method of creating a treatment strand with tubular treatment seeds threaded together through a bore in each treatment seed with a biocompatible material, and spaced according to a treatment plan. Reconsideration of this rejection respectfully is requested.

The examiner rejected claim 6 under section 103(a) over Kaplan as applied to claim 1, in view of Mentor Corporation. Claim 6 depends from claim 1, and therefore is not obvious over Kaplan in view of Mentor Corporation for the reasons set forth in connection with addressing the rejection of claim 1 over these same references. Applicant respectfully requests reconsideration of the rejection.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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By: \_\_\_\_\_

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